

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 200310842-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Peter J. Fricke et al.

Confirmation No.: 5316

Application No.: 10/772,945

Examiner: NADAV, Ori

Filing Date: February 4, 2004

Group Art Unit: 2811

Title: Memory Array with Two-Terminal Crosspoints Using Silicon-Rich Insulator

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 20, 2009.

☐ The fee for filing this Appeal Brief is \$540.00 (37 CFR 41.20).

☒ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$130

☐ 2nd Month
\$490

☐ 3rd Month
\$1110

☐ 4th Month
\$1730

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Re

Peter J. Fricke et al.

By

Steven L. Nichols

Attorney/Agent for Applicant(s)

Reg No. : 40,326

Date : June 8, 2009

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of
Peter J. Fricke et al.
Application No. 10/772,945
Filed: February 4, 2004
For: Memory Array with Two-Terminal
Crosspoints Using Silicon-Rich
Insulator (as amended)

Group Art Unit: 2811

Examiner: NADAV, Ori

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**RESPONSE TO ERRONEOUS NOTICE OF NON-COMPLIANT
APPEAL BRIEF**

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In an erroneous Notice of Non-Compliant Appeal Brief dated May 8, 2009 (the "Notice"), the Office objected to Appellant's Brief filed January 20, 2009 on grounds that Appellant has not properly provided a concise explanation of the claimed subject matter as required by 37 C.F.R. § 41.37. Appellant vehemently disagrees.

The Notice argues as follows. “The brief fails to describe in the summary of claimed subject matter each dependent claim argued separately.” (Notice, p. 1). In response, Appellant respectfully submits that the Examiner has misread and misapplied the applicable rule.

In pertinent part 37 C.F.R. § 41.37 states:

(v) Summary of claimed subject matter. ...for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, *every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph*, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

37 C.F.R. § 41.37(v) (emphasis added).

Thus, the applicable rule makes it perfectly clear that only dependent claims that are in “means plus function” or “step plus function” form and argued separately need be included in, or addressed in, the Summary of Claimed Subject Matter of the Appeal Brief. 37 C.F.R. § 41.37 clearly does not require, as the Notice incorrectly implies, that *any* dependent claim separately argued must be addressed in the Summary of Claimed Subject Matter.

In the present case, there are no dependent claims separately argued that are in “means plus function” or “step plus function” form. Claim 16, which is independent and which is addressed in the Summary of Claimed Subject Matter, is the only means-plus-function claim in the application. Consequently, Appellant properly did not address any of the separately-argued dependent claims in the Summary of the Claimed Subject Matter.

Therefore, Appellant's Brief is fully compliant with the applicable rule. The Notice of Non-Compliant Brief is in error and should be immediately withdrawn. Notice to that effect is respectfully requested.

Respectfully submitted,

DATE: June 8, 2009

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